

## REMARKS

The foregoing amendments are submitted in response to the Office Action dated August 6, 2004. The examiner's comments have been carefully considered, and are addressed in turn in the following paragraphs.

Response to Objection to Drawings under 37 C.F.R. 1.165(a).

The examiner has objected to the disclosure for failing to depict all the distinctive characteristics of the claimed plant. By the foregoing amendment, applicant has provided new illustrations of the claimed tree, showing the tree, fruit, leaves and flowers. Applicant believes that the newly presented illustrations meet the requirements of 37 C.F.R. 1.165(a).

Response to Rejection under 35 U.S.C. §112 and Objection to Disclosure under 37 C.F.R. 1.163:

The examiner has objected to the disclosure under 37 CFR §1.163 and rejected the claim under 35 USC §112, first and second paragraphs, as failing to provide a reasonably complete botanical description of the claimed plant.

The examiner has objected to the disclosure under 37 CFR §1.163 and 35 USC §112, first paragraph. The objection to the disclosure is followed by a highly detailed request for additional descriptive information regarding the new variety. The examiner cites 35 USC §162 to support the objection and request for additional descriptive information.

35 USC §162 reads:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

Amendments to the Drawings

Please cancel the drawing as filed in favor of the enclosed new drawings, Figs. 1 through 6.

No new matter is added by the entry of these drawings, which are provided at the request examiner to more fully illustrate the claimed plant.

This statute acknowledges that an enabling written description cannot be provided for a plant, and so allows instead a reasonably complete description. Applicant asserts that for the purposes of a plant patent specification, a reasonably complete description identifies the novel, distinguishing, and non-variable characteristics of a new plant variety, and additionally points out commercially relevant features of the variety. This assertion is borne out in 37 CFR §1.163(a):

The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents. . .

A reasonably complete description does not include each and every quantifiable feature of the plant. While a highly detailed description may have merit for some purposes (breeding program records, botanical publications, researcher's notes, etc.), it is neither required by law nor appropriate in a plant patent application.

The grant of a plant patent is described in 35 USC §163:

In the case of a plant patent, the grant shall include the right to exclude others from asexually reproducing the plant, and from using, offering for sale, or selling the plant so reproduced, or any of its parts, throughout the United States, or from importing the plant so reproduced, or any parts thereof, into the United States.

The botanical description and illustrations included in a patent for a new plant variety, combined with the claimed plant itself (or its asexually produced progeny), define the invention in which exclusive rights are claimed.

No amount of description, or lack thereof, will affect the scope of the claim in a plant patent. The claim of a plant patent includes the specific plant, including any of its parts, shown and described in the specification. No more, no less. By excluding variable and commercially irrelevant

description from the specification, the applicant does not, and can not broaden the scope of the plant patent claim defined by the statute.

In order to enforce a plant patent against an infringer, the patentee must prove that the alleged infringing plant is an asexual reproduction, that is, that it is the progeny of the patented plant. *Imazio Nurseries, Inc. v. Dania Greenhouses*, 69 F.3d 1560, citing *Yoder Bros., Inc. v. California-Florida Plant Corp.*, 537 F.2d 1347, 1390, 193 USPQ 264, 293. A highly detailed and exacting patent specification may be appealing to a botanist, a patent examiner, or a patent applicant, but it is not more useful or valuable in enforcing the exclusive rights of the patent owner than a reasonably complete specification that points out the distinguishing characteristics of the variety.

Many of the characteristics for which the examiner has requested additional descriptive information are subject to substantial variability. Some of the variables which can affect the observable characteristics of fruit trees include: soil type; fertilizers and agricultural chemicals; weather; climate; watering; plant stress; cultural practices; and disease.

A quantitative recitation of variable characteristics fails as a reasonably complete description as required by the statute. Without taking into consideration the unique attributes of plants as patentable subject matter, one might conclude that if some description is good - reasonably complete - then more description must be better. In a utility patent application, this may be true. Devices, compounds and methods are described in terms of physical properties bound by physical laws. In order to enable the invention claimed in the utility application, it may be necessary to provide a quantitative recitation of the physical characteristics of the invention, in some cases with a high degree of precision.

In contrast, no such enabling description is required, or even possible, in a plant patent application. The botanical description in a plant patent application is intended to aid in identifying

the claimed plant, not to enable the reader to make the invention. A botanical description which exceeds the reasonably complete standard by providing description of variable characteristics does not aid in identifying the plant, but in fact introduces vague and ambiguous information. So, rather than serving to improve the quality of the disclosure in a plant patent application, the addition of unnecessary, vague or ambiguous information diminishes its value as an aid in identifying the claimed plant. Applicant asserts that a reasonably complete description of a plant is limited to those characteristics which are used by those skilled in the art to identify plants of the variety claimed.

In the interest of obtaining allowance of the present application, applicant has attempted to gather the information requested by the examiner. The additional information has been incorporated into the specification, and is reflected in the attached substitute specification. Applicant believes that the amendment addresses all of the examiner's concerns regarding adequacy of disclosure, and respectfully requests that the rejection and objection be withdrawn.

Each of the examiner's specific concerns is addressed in the following paragraphs.

A.     Age/Growing Conditions: The specification has been amended to point out the age and growing conditions of the observed tree.

B.     Asexual Reproduction: The specification has been amended to point out where and in what manner asexual reproduction has taken place.

C.     Distinguishing Characteristics: The specification has been amended to point out the distinctive and desirable features of the new variety.

D.     Rootstock: The specification has been amended to include information regarding the rootstock on which test trees were grown. The new variety has not been grown on its own roots.

E. – R. Specific Botanical Characteristics: The information requested by the Examiner in paragraphs E. through R. has been added to the specification in the foregoing amendment. To the

extent that requested information is not provided, Applicant was unable to obtain the information due to seasonal limitations, and respectfully requests that those requirements be waived. Specific omissions are discussed below:

1. Applicant has attempted to provide as much information as possible regarding the reproductive organs of the claimed variety, as requested by the Examiner. In addition to the fact that these characteristics are subject to seasonal unavailability, they are also rarely evaluated in commercial fruit trees. In the case of ornamental flowers, such detail may be justified, but in the case of commercial fruit trees, such data is not typically gathered. Therefore, Applicant requests that no additional information regarding the flowers be required.
2. Applicant has not provided information regarding shipping and keeping quality of the fruit of the claimed variety, as no such evaluations have yet been conducted.
3. The chilling requirement for the claimed variety is not discernable. In the growing area where this variety was tested, achieving the necessary minimum number of chilling hours is not an issue because of the cold winter climate.

Rejection under 35 U.S.C. 102(b)

The examiner has rejected the claim in this application on the basis that the written description provided does not distinguish the claimed plant over the plant described in U.S. Patent No. 12,008. By the foregoing amendment, applicant has provided substantial botanical description of the claimed plant which distinguishes it over the '008 patent. Most notably, the fruit of the claimed variety is oblate (flat), whereas the nectarine described in the '008 patent is globose, or nearly round, in shape. Other differences are apparent in comparing the two descriptions. Applicant

believes the rejection under 35 U.S.C. 102(b) citing the '008 patent is overcome by the foregoing amendment.

In addition to the apparent differences between the fruit of 'S 6816' and that of the '008 patent, it is significant to note that 'S 6816' was sexually bred. 'S 6816' is a genetically unique new plant, *per se* novel, and cannot be anticipated by any other plant of distinct origin.

## CONCLUSION

In light of the foregoing amendment and remarks, applicant asserts that this application is in condition for allowance, and such action is now respectfully requested. The examiner is invited to contact applicant's undersigned representative regarding any remaining issues that require attention.

Respectfully Submitted,

STRATTON BALLEW PLLC



Michelle Bos, PTO Reg. No. 45,499  
213 S. 12<sup>th</sup> Avenue  
Yakima, WA 98902  
Telephone (509) 453-1319  
Facsimile (509) 453-4704